

REMARKS

The within Amendment is being filed in response to a Final Office Action mailed on November 15, 2007.

Claims 1 - 135 are pending in the application. Claims 1, 7, 8, 43, 45, and 46 have been amended. Claims 5, 6, and 136 - 221 have been cancelled. New claims 222 - 227 are herein added. No new matter has been added. Support for the new claims and amendments can be found in the specification and claims as filed, for example at paragraphs [0118] – [0120].

Any cancellation of the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Claim Objections

The Examiner has indicated that claims 5 - 9, 11, 15, 19 – 21, 23 – 28, 44, 45, 47 – 49, 52, 57, 58, 61 and 65 – 135 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims.

Applicants have amended the base claims to overcome the rejections and respectfully request that the claim objections be withdrawn.

Claim Rejections

35 U.S.C. § 102(b)

Claims 1 – 4, 10, 12 – 14, 16 – 18, 22, and 54 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Holmes et al. (USPN 3,867,201; “the ‘201 reference” herein). Applicants respectfully traverse the rejection, but in the interest of expediting prosecution have herein amended claim 1. As amended claim 1 requires a tip-electrode comprising a housing defining a lumen for receiving an electrically conductive medium; and

an electrically conducting surface for coupling to a voltage or current generator, wherein the electrically conducting surface comprises a structure conformed to fit into the housing defining the lumen of the tip-electrode.

The Examiner argues that “the device disclosed in the (Holmes) reference would be useable as a tip electrode.” (Office Action, p.2). The Examiner argues that “essentially any metallic object can be electrified, and there is nothing disclosed by Holmes that would suggest that the reference invention could not be electrified.” (Office Action, p.3).

In order for a reference to anticipate the pending claims, the reference must teach each and every element that is set forth in the claims, either expressly or inherently (see, *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987) and MPEP 2131).

Nowhere does the '201 reference, expressly or inherently, teach or describe a tip-electrode comprising **a housing defining a lumen for receiving an electrically conductive medium**; and an electrically conducting surface for coupling to a voltage or current generator, **wherein the electrically conducting surface comprises a structure conformed to fit into the housing defining the lumen of the tip-electrode**.

The '201 reference teaches an electrolyte battery cell container. The invention is directed to a method of filling a sealed cell with an electrolyte, and to provide a simple structural arrangement that will provide a reliable seal for the cell. (col 1, lines 20 – 30). The '201 reference simply teaches “a piercing needle (that) may be inserted to inject the fluid electrolyte into the space between the electrode elements.” (col 2, lines 30 – 33).

The '201 reference nowhere teaches or suggests a housing defining a lumen for receiving an electrically conductive medium and an electrically conducting surface for coupling to a voltage or current generator, wherein the electrically conducting surface comprises a structure conformed to fit into the housing defining the lumen of the tip-electrode.

Applicants direct the Examiner to the instant application, for example at paragraph [0118], that describes the electrically conductive surface as an element that conforms to fit into the lumen of the housing:

The electrically conductive surface may be an element removable from the housing or can be an integral component of the housing. See, e.g., FIG. 9D. In one aspect, the electrically conductive surface of the tip-electrode is in the form of a rod, cylinder, wire, or other electrically conducting structure conformed to fit into the lumen of the tip-electrode... However, the electrically conducting structure may be placed anywhere on the inside of the lumen of the housing of the tip-electrode

Figure 9, illustrates that the electrically conductive surface may be an element that is removable from the housing or can be an integral component of the housing.

Thus, the '201 reference fails to teach all the elements of the invention as claimed, and accordingly Applicants request withdrawal of the rejection and allowance of the claims.

Claims 43, 46, 50, 51, 53, 55, 56, 59, 60, and 62 - 64 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kornstein et al. (WO 95/23211; "the '211 reference" herein). Applicants respectfully traverse the rejection.

As set forth in the previous Office Action, the Examiner alleges that the '211 reference "teaches a device having an electrode plate which has a two-dimensional array of tube-like non-planar extensions which extend from one surface, which thus forms lumens, which lumens permit the passage of tip electrodes and which hold and align them in an array, permitting vertical movement and withdrawal from the target (Office Action, p.7)." Applicants respectfully traverse the rejection.

The '211 reference does not anticipate the claimed invention. Nowhere does the '211 reference, expressly or inherently, teach or describe a tip-electrode plate comprising a substantially planar plate on which at least one non-planar element is fabricated thereon, wherein the non-planar element has **an electrically conductive medium**, and an **opening for exposing a target to an electric field and for the delivery of an agent** from the opening to the target, and wherein inner walls of the non-planar element define a lumen.

The '211 reference merely describes an apparatus for the electroporation of cells or tissue with needle electrodes. The needle electrodes described in the '211 reference protrude from support tubes so as to directly contact the base of a Petri dish (See Fig. 3 and page 10, lines 15-30). Nowhere is a tip-electrode having an electrically conductive medium and an opening for exposing a target to an electric field and for the delivery of an agent suggested or taught by the '211 reference. The '211 reference does not teach the presence of a conductive medium in the support tubes. Furthermore, the '211 reference does not teach a tip electrode for delivering an agent. As is evident in the '211 publication (See Fig. 3 and page 10, lines 15-30) the support tubes are simply attached to a support plate and are not capable, in the described configuration, of delivering an agent. Furthermore, dependent claim 48 requires that the plate contains a reservoir. The use of a reservoir within the meaning of the present claims is not contemplated or described in the '211 publication.

Thus, the '211 reference fails to teach all the elements of the invention as claimed, and accordingly Applicants request withdrawal of the rejection and allowance of the claims.

CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment to Deposit Account No. 04-1105.

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Respectfully submitted,



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